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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,230	02/09/2001	Andreas Manz	0225-0066.22	8918

22918 7590 07/30/2004

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EXAMINER

STARSIK, JOHN S

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/780,230	Applicant(s) MANZ ET AL.	
	Examiner John S. Starsiak Jr.	Art Unit 1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/226,605.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites, "...applying an electric field across the sample channel and a *drain channel...*". The claim fails to recite any structural relationship between the "drain channel" and the other elements recited in the claim, e.g., the sample channel, the electrolyte channel, and in particular the drain port. Specifically, claim 19 fails to recite the drain port constitutes the intersection of the drain channel and the electrolyte channel. Claim 19 recites "a reservoir for an electrolyte buffer and a drain at an opposite end of the electrolyte channel". This recitation is incomplete because the recitation fails to recite that the reservoir for the electrolyte buffer is at the end of the electrolyte channel opposite the drain. Moreover, without this structural particular, there is no frame of reference for "opposite end". Claim 20 recites "the potential at the reservoir". There is no antecedent basis for this recitation in claim 19. Claim 20 recites "the electrolyte buffer is allowed to advance into said sample channel and into said drain

channel". This is indefinite because, while the electrolyte buffer recited here is not electrolyte buffer in the reservoir. Claim 21 is rejected because it depends on claim 20.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, and 6 of U.S. Patent No. 6,280,589. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are slightly broader than the claims in U.S. Patent 6,280,589. Specifically the claims in the present application recite a desired result, i.e. "the sample plug having the same composition of sample components" and the claims of U. S. Patent 6,280,589 also recite the desired resulted result and the manipulative step which produces the desired result, i.e., "wherein said electric field is applied for a time period which is at least long enough that

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the component having the lowest electrophoretic mobility migrates into the geometrically defined sample volume, such that the injected sample plug reflects the original sample composition.”. Also, the claims in the present application do not recite that “said supply channels and drain channels are each inclined with respect to the electrolyte channel”. The principles set forth in *In re Goodman* apply. The Office did not prevent the applicant from prosecuting the claims of the present applicant during the prosecution of the patent application, which became U.S. Patent 6,280,589. The allowance of these broader claims would inherently extend “the right to exclude” of the narrower claims of U.S. Patent 6,280,589. Hence an obvious double patenting rejection is proper.

### ***Response to Arguments***

Applicant's arguments with respect to claims 19-21 have been considered but are moot in view of the new ground(s) of rejection.

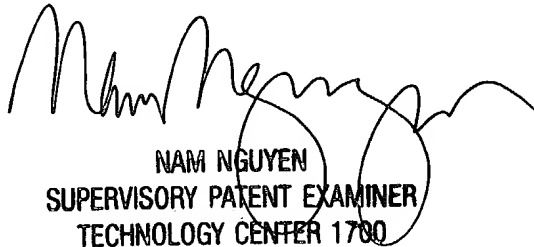
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Starsiak Jr. whose telephone number is (571) 272-1346. The examiner can normally be reached on Monday to Friday from 8:00 AM to 4:30 PM.

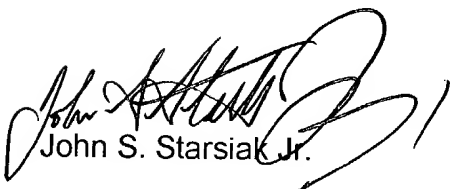
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



NAM NGUYEN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700



John S. Starsiak, Jr.

23 July 2004